

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 10-12 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Inventions I (claims 1 and 9) and II (claims 10-12) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be practiced with another materially different product such as an anticancer agent, since other compounds also derived from Hongdoushan (*Taxus yunnanensis*), such as Taxol, are known anticancer agents. Furthermore, since the plant is effective for anti-inflammation, diuresis, lowering blood pressure, decreasing lipids in the blood and the like, one skilled in the art would reason that compounds isolated from Hongdoushan, such as those of formula (1), would also have such activity.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-12 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Applicant's Arguments***

Applicants' arguments, filed 10/29/07, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

***Claim Rejections - 35 USC § 112***

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mujumdar et al., Indian J. Chem., vol. 10, pp. 677-680 (1972).

Mujumdar et al. disclose the compound taxiresinol. The compound anticipates the compositions of claims 1 and 9 comprising taxiresinol. The descriptions of "hypoglycaemic agent" (claim 1) and "hepatoprotective agent" (claim 9) are intended use limitations and not given any patentable weight because they are not deemed to limit the claims. Therefore, the prior art's description of taxiresinol anticipates the compositions comprising taxiresinol.

Applicants argue that Mujumdar et al. does not disclose or suggest the functional language added to claims 1 and 9 in the amendment dated 10/29/07, and one having ordinary skill in the art would not have been motivated to achieve the result of decreasing blood glucose levels and inhibiting an increase in levels of glutamic-pyruvic transaminase and glutamic oxaloacetic transaminase in bloom serum. This is not found to be persuasive because the added language in each claim is drawn to a methodology, and the claims 1 and 9 are not method claims, but rather product claims. Therefore, the added functional language is not deemed to further limit the

claims, and the prior art's description of taxiresinol anticipates the compositions comprising taxiresinol.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Shen et al., Chinese Pharmaceutical Journal (Taipei), vol. 49, No. 5-6, 1997, pp. 285-296.

Shen et al. disclose the compound taxiresinol (abstract, line 2, page 285, and compound 7, page 288) exhibiting potent cytotoxicities. The compound anticipates the compositions of claims 1 and 9 comprising taxiresinol. The descriptions of "hypoglycaemic agent" (claim 1) and "hepatoprotective agent" (claim 9) are intended use limitations and not given any patentable weight because they are not deemed to limit the claims. Therefore, the prior art's description of taxiresinol anticipates the compositions comprising taxiresinol.

Applicants argue that Shen et al. does not disclose or suggest the functional language added to claims 1 and 9 in the amendment dated 10/29/07, and one having ordinary skill in the art would not have been motivated to achieve the result of decreasing blood glucose levels and inhibiting an increase in levels of glutamic-pyruvic transaminase and glutamic oxaloacetic transaminase in bloom serum. This is not found to be persuasive because the added language in each claim is drawn to a methodology, and the claims 1 and 9 are not method claims, but rather product claims. Therefore, the added functional language is not deemed to further limit the claims, and the prior art's description of taxiresinol anticipates the compositions comprising taxiresinol.

Applicants further note that Shen does not disclose taxiresinol exhibiting cytotoxicities, citing Table 1 of Shen. This note does not appear to be relevant to the instant rejection, since the prior art's description of taxiresinol still anticipates the compositions comprising taxiresinol.

### *Claim Objections*

Claim 9 is objected to because of the following informalities: the phrase "bloom serum" appears to be a typographical error. Appropriate correction is suggested.

### *Action is Final*

Applicant's amendment necessitated the new ground(s) of rejection, objection, and/or restriction presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Frazier whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 8am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718, or Cecilia Tsang can be reached on (571)272-0562. The fax phone number for the organization where this application proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

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